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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,911	06/08/2001	Andrew N. Schick	007720.111190 (MMCD41)	1117

7590 09/23/2004

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EXAMINER

BOUTAH, ALINA A

ART UNIT PAPER NUMBER

2143

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/876,911

**Applicant(s)**

SCHICK ET AL.

**Examiner**

Alina N Boutah

**Art Unit**

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/25/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Double Patenting***

Claims 1-9 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 10-18. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPAPN 2002/0141095 issued to Yahiro in view of USPAPN 2003/0212759 issued to Wu.

Regarding claim 1, Yahiro teaches a method of marking data objects on an electronic device to be transferred by the electronic device, the method comprising the steps of:

a) presenting a user interface of the electronic device [0031];

b) applying a set of criteria to the data object to determine if the data object is capable of being transferred [Abstract; 0013-0014]; and

c) providing an indicator if the data object is capable of being transferred by the electronic device [Abstract].

However, Yahiro does not explicitly teach presenting a data object on the user interface of the electronic device although he discloses an interface of a transmitting device to another device [figure 2]. Wu teaches presenting a data object on the user interface of the electronic device (abstract, figures 1 and 3). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to employ a data object on the user interface of the electronic device in order to allow users to select data object to be transferred, therefore ensuring that the user will transfer the intended data object, thus minimizing transfer errors.

Regarding claim 2, Yahiro teaches the method of claim 1, wherein presenting a data object on the user interface of the electronic device comprises displaying the data object on a display of the electronic device [figures 1, ref. 10].

Regarding claim 3, Yahiro teaches the method of claim 1, wherein if the data object is capable of being transferred, further comprising the steps of: e) transferring the data object [abstract].

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However, Yahiro fails to explicitly teach d) allowing the data object to be selected for transfer. Wu teaches d) allowing the data object to be selected for transfer [0020]. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to allow the data object to be selected for transfer in order to ensure that the user will transfer the intended data object.

Regarding claim 4, Yahiro fails to teach the method of claim 3, wherein the step of allowing the data object to be selected for transfer further comprises adding the data object to a modifiable list of data objects selected for transfer. Wu teaches adding the data object to a modifiable list of data objects selected for transfer [0005]. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to add the data object to a modifiable list of data objects selected for transfer in order to provide users with visual content that will ensure that the user will transfer the intended data object.

Regarding claim 5, Yahiro teaches the method of claim 1, wherein the applying a set of criteria step comprises the step of retrieving one or more attributes of the data object and determining if the attributes exceed predetermined transfer limitations [abstract].

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Regarding claim 6, Yahiro teaches the method of claim 5, wherein the predetermined transfer limitations comprise file size limitations, confidentiality limitations, and file type limitations [0039-0044].

Regarding claim 7, Yahiro teaches the method of claim 1, wherein the step of providing an indicator comprises presenting an icon on the user interface of the electronic device [0045].

Regarding claim 8, Yahiro teaches the method of claim 1, wherein the step of providing an indicator comprises sounding an auditory alert on the electronic device [0045].

Regarding claim 9, Yahiro teaches the method of claim 1, wherein the step of providing an indicator comprises illuminating a dedicated button on the electronic device [0045].

Claims 10-18 duplicate with claims 1-9, therefore are rejected under the same rationale.

Regarding claim 19, Yahiro teaches a method of marking a plurality of data objects on an electronic device for transfer, comprising the steps of:

a) presenting a first data object [abstract];

b) applying a set of criteria to the data object to determine if the first data object is capable of transfer [Abstract; 0013-0014]; and

c) providing an indicator if the first data object is capable of being transferred by the electronic device [abstract; 0045].

However, Yahiro fails to explicitly teach d) allowing user to select the first data object for transfer; e) adding the selected data object to a list of data objects for transfer; f) presenting a next data object; and g) repeating steps b) through e) with said next data object.

Wu teaches d) allowing user to select the first data object for transfer [0020]; and e) adding the selected data object to a list of data objects for transfer [0020]. Although Wu does not explicitly disclose f) and g), one of ordinary skill in the art would have recognized that when sending multiple data objects, it is well known in the art that subsequent data objects are presented and that the steps of b) to e) are repeated.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teaching of Yahiro with the teaching of Wu in order to allow the data object to be selected for transfer in order to ensure that the user will transfer the intended data object, thus minimizing transfer errors.

Regarding claim 20, Yahiro fails to explicitly teach the method of claim 19, wherein list of data objects selected for transfer may be edited before transfer by the electronic device. Wu teaches editing a list of data objects selected for transfer [0020]. At the time the invention was



made, it would have been obvious to one of ordinary skill in the art to modify the list of data objects in order to ensure that users will transfer the intended data object.

Regarding claim 21, Yahiro teaches the method of claim 19, wherein the applying a set of criteria step comprises the step of retrieving the attributes of said first data object and determining if the attributes exceed predetermined transfer limitations [abstract].

Regarding claim 22, Yahiro teaches the method of claim 21, wherein the predetermined transfer limitations comprise file size limitations and file type limitations [abstract].

Regarding claim 23, Yahiro teaches the method of claim 19, wherein indicating on the user interface if the first data object is capable of transfer by the electronic device step comprises presenting an icon on the user interface of the electronic device [0045].

Regarding claim 24, Yahiro teaches the method of claim 19, wherein the providing an indicator step comprises sounding an auditory alert on the electronic device [0045].

Regarding claim 25, Yahiro teaches the method of claim 19, wherein the providing an indicator step comprises illuminating a dedicated button on the electronic device [0045].

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Regarding claim 26, Yahiro teaches an apparatus capable of transferring one or more data objects, the apparatus comprising:

a) a memory device for containing a program module and at least one data object [figure 1];

b) a user interface [figure 1]; and

c) a processing unit coupled to the memory device and the user interface, the processing unit being operative in response to the instructions of the program module to:

i) present a data object on a user interface of the electronic device [abstract];

ii) apply a set of criteria to the data object to determine if the data object is capable of being transmitted [0039-0044]; and

iii) provide an indicator if the data object is capable of being transmitted [0045].

Regarding claim 27, Yahiro teaches the apparatus of claim 26, wherein if the processing unit determines that a data object is capable of being transmitted, further being operative in response to the instructions of the program module to:

d) allow the data object to be selected for transmission over a communications medium [abstract]; and

e) transmit the data object [abstract].

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Regarding claim 28, Yahiro teaches the apparatus of claim 26, wherein the apparatus is a cellular telephone [0003].

Regarding claim 29, Yahiro teaches the apparatus of claim 26, wherein the apparatus is a computer with a modem [0003].

Regarding claim 30, Yahiro teaches the apparatus of claim 26, wherein the apparatus is a hand held computer [0003].

Regarding claim 31, Yahiro teaches the apparatus of claim 26, wherein the apparatus is a telephone [0003].

Regarding claim 32, Yahiro teaches the apparatus of claim 26, wherein the communications medium is a wireless medium [0003].

Regarding claim 33, Yahiro teaches the apparatus of claim 26, wherein the communications medium is a data channel of a cellular transmission medium [0003].

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Regarding claim 34, although Yahiro and Wu do not explicitly teach the apparatus of claim 26, wherein the communications medium is an optical medium, one of ordinary skill in the art would have expected the claimed invention to perform equally well with other types of transmission.

Regarding claim 35, Yahiro teaches the apparatus of claim 26, wherein the communications medium is a wired medium [0003].

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. USAPN 2004/0048622 by Witkowski et al.
2. USPN 5,640,193 issued to Wellner.
3. USPN 5,740,364 issued to Drerup.
4. USPN 6,128,668 issued to Barber et al.
5. USPN 5,845,282 issued to Alley et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N Boutah whose telephone number is (703) 305-5104. The examiner can normally be reached on Monday-Thursday (9:00 am-7:00 pm).


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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